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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,944	10/04/2004	Martin Konemann	259560US0PCT	4976
22850	7590	12/29/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ANTHONY, JOSEPH DAVID				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/29/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/509,944

**Applicant(s)**

KONEMANN ET AL.

**Examiner**

Joseph D. Anthony

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9-13,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**SECOND ACTION NON-FINAL**

***Election/Restrictions***

Newly submitted claims 15-18 and 21, are directed to an invention that is independent or distinct from the invention originally claimed because these new claims are all ultimately dependent on independent claim 6 which was non-elected by applicant in applicant's response filed 11/12/07. As such, new claims 15-18 and 21 are being held as non-elected for the same reasons set forth by the Examiner for why claims 6-8 and 14 were previously deemed independent or distinct over claims 1-2, 4-5, and 9-13.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-18 and 21 are also withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-5, 9-13 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 is deemed to be indefinite in regards to the limitation of: "on average from 0.05 to 100% of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> present in the molecule are not hydrogen".

The claim is deemed to be indefinite because the Examiner is unable to see how a lower limit of "0.05" % is possible in light of formula (I). Assuming for argument sake that in formula (I),  $n$  is equal to 1, then the total number of  $R^1$ ,  $R^2$ , and  $R^3$  groups would be 12 in the compound (i.e. 4  $R^1$  groups + 4  $R^2$  groups + 4  $R^3$  groups). Since it is impossible for any one of  $R^1$ ,  $R^2$ , and  $R^3$  groups to be less than a positive integer, this means that at a minimum at least 1 out of the 12 total  $R^1$ ,  $R^2$ , and  $R^3$  groups is NOT a hydrogen group. As such, the minimum calculate percentage of non-hydrogen groups in the molecule is approximately **8.33% if  $n$  is 1**.

If on the other hand,  $n$  is set to the maximum of 7, then a total of 30  $R^1$ ,  $R^2$ , and  $R^3$  groups are present in the molecule of formula (I). Since it is impossible for any one of  $R^1$ ,  $R^2$ , and  $R^3$  groups to be less than a positive integer, this means that at a minimum at least 1 out of the 30 total  $R^1$ ,  $R^2$ , and  $R^3$  groups is NOT a hydrogen group. As such, the minimum calculate percentage of non-hydrogen groups in the molecule is approximately **3.33% if  $n$  is 7**.

Likewise, claim 1 is indefinite because it depends on independent claim 1, and also because in regards to the limitation of: "on average from 0.01 to 12 of  $R^1$ ,  $R^2$ , and  $R^3$  present in the molecule are not hydrogen". Is applicant trying to claim an actual number of  $R^1$ ,  $R^2$ , and  $R^3$  groups, or did applicant forget to insert a '%' symbol?

Likewise, claim 20 is indefinite because it depends on independent claim 1, and also because in regards to the limitation of: "on average from 1 to 8 of  $R^1$ ,  $R^2$ , and  $R^3$  present in the molecule are not hydrogen". Is applicant trying to claim an actual number of  $R^1$ ,  $R^2$ , and  $R^3$  groups, or did applicant forget to insert a '%' symbol?

All other dependent claims are being rejected here because they are dependent on a rejected base claim and are thus indefinite.

***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 4-5, and 9-13 over the previous applied prior-art references, have been considered and have been dropped in light of applicant's amendment and arguments filed 09/17/08.

***Examiner Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

**/Joseph D. Anthony/  
Primary Patent Examiner  
Art Unit 1796  
12/22/08**